

## REMARKS

Upon entry of this amendment, claims 1 and 13–26 will be pending in the application. Claims 2–12 are cancelled. Claim 1 is amended herein for clarity and focus on the invention. Claims 13–26 are new. Applicants submit that the amended and new claims are supported by the original claims, specification, and drawings—for example page 11 lines 11–18, page 11 line 22–page 12 line 17, and FIG. 3. The objection and rejections of the Office Action dated May 2, 2008 are addressed individually below.

### Objection to the Drawings

The drawings were objected to as failing to comply with 37 C.F.R. 1.84(p)(5) because Figure 1 includes a reference character “S6” not mentioned in the description. The specification is amended herein to refer to step S6 in Figure 1. Accordingly, Applicants submit that the objection to the drawings has been overcome.

### Rejection under 35 U.S.C. § 112

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph as being allegedly indefinite for lack of antecedent basis for “the additional topics”. By this amendment, claim 7 is cancelled, rendering this § 112 rejection moot.

### Rejection under 35 U.S.C. § 102

Claims 1–5 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by the Federal Human Resource Development Council publication “Getting Results Through Learning” (May 1997; hereinafter “FHRDC”). Applicants respectfully traverse this rejection.

Applicants’ claim 1 is amended herein to focus on aspects of virtual mentoring that are specific virtual mentoring of claim professionals of an insurance organization. In particular, claim 1 is amended to clarify the use of predictive modeling, which comprises performing text and data mining of claim data collected from a plurality of claims of the insurance organization and performing predictive modeling of the claim data. This predictive modeling is described, for example, at page 11 lines 11–21 and page 14 lines 12–20 of the specification, and is part of the predictive logic (see, e.g., page 14 lines 20–25 and FIGS. 2 and 3) of the virtual mentoring method as claimed. A method of

virtual mentoring comprising predictive modeling of claim data collected from a plurality of claims of an insurance organization, as claimed, is not described or suggested in FHRDC.

Appendix C of FHRDC, cited in the Office Action, discusses data gathered regarding employees' "performance gaps or opportunities" (FHRDC, page 53), and summaries of conclusions of such studies (FHRDC, page 54). Classroom and electronic learning and performance strategies are described, generally, as being designed and selected to provide "just in time", "just the right" amount of content (FHRDC, pages 54 page 56). Cost-benefit analysis of the learning process is "consistently used in learning project proposals" and includes, for example "audience size" and "all costs associated with the design, development, implementation, delivery, and maintenance of the learning process for its estimated life" (FHRDC, page 55). However, FHRDC does not, at Appendix C or elsewhere, disclose a method of virtual mentoring that incorporates predictive modeling of claim data collected from a plurality of claims of an insurance organization, as claimed.

Thus, Applicants respectfully submit that, for at least this reason, the combination of elements recited in amended independent claim 1 is not anticipated by FHRDC. New independent claims 13 and 26, which also recite predictive modeling, and dependent claims 14–25, which recite further limitations to claim 13, are likewise distinguished. Claims 2–5 are cancelled. Accordingly, reconsideration and withdrawal of the § 102 rejection in view of FHRDC is respectfully requested.

### **Rejections under 35 U.S.C. § 103**

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being allegedly obvious in view of FHRDC and Official Notice.

Claims 8–11 were rejected under 35 U.S.C. § 103(a) as being allegedly obvious in view of FHRDC and Sketch (U.S. Patent Application Publication No. 2002/0077884), and in further view of Official Notice (claim 11).

Claim 12 was rejected 35 U.S.C. § 103(a) as being allegedly obvious in view of FHRDC and Sketch, and in further view of Hopkins *et al.* (U.S. Patent No. 6, 687,485).

By this amendment, claims 2–12 are cancelled, rendering these § 103(a) rejections moot.

## CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, to the extent Applicants have discussed specific elements of the claims, Applicants have merely provided examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution and/or explicitly recite that which is already present within the claims as interpreted in view of the specification. Moreover, Applicants reserve the right to pursue the original and/or complimentary subject matter recited in the present claims in a continuation application.

Any claims that have been cancelled are hereby cancelled without prejudice or disclaimer, and Applicants reserve the right to further prosecute these claims in continuing applications. In addition, Applicants have attempted to claim all embodiments disclosed in the present application, and no disclaimer of any embodiments is hereby intended by the presently pending claims.

Any narrowing amendments made to the claims, if any, in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents and/or statutory equivalents, *i.e.*, all equivalents that are substantially the same as the presently claimed invention.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

Applicants also traverse any "Official Notice," "Design Choice," "Admitted Prior Art" or other alleged prior art that the Examiner purports are well known with respect to the claimed combination of the present invention. Applicants disagree and request the Examiner to provide a prior art reference describing any of these features that the Examiner has not provided a prior art reference for or an affidavit under 37 C.F.R. Section 1.104(d)(2) providing details of why it would have been obvious. In the absence of either, Applicants request withdrawal of this rejection for these reasons as well.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

### **AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,  
WILMER CUTLER PICKERING HALE AND DORR LLP

Date: October 31, 2008

Irah H. Donner  
Irah H. Donner  
Registration No. 35,120

399 Park Avenue  
New York, NY 10022  
Tel: (212) 230-8887  
Fax: (212) 230-8888